REMARKS

Claims 9 and 11-22 are pending in the present application.

The rejection of Claims 3-4, 6-9, and 11-22 under 35 U.S.C. §103(a) over Ishioka et al (Am J Ophthalmol. 1994 Dec 15;118(6):723-9) in view of Stuchlik et al (WO 99/34830) is traversed in part and obviated in part by amendment.

Claims 3, 4, and 6-8 have been canceled in response to the outstanding Office Action.

The present invention provides, in part, a method for treating retinopathy, comprising administering to a subject in need thereof an effective amount of an agent comprising a tricyclo compound of formula (I) or a pharmaceutically acceptable salt thereof. (Claim 13)

In contrast, Ishioka et al disclose the clinical effects of the immunosuppressive agent FK506 in patients with noninfectious uveitis. Applicants note, however, that uveitis is not the same as or related to retinopathy. Uveitis is an inflammatory condition of the uvea, which includes that iris, ciliary body, and chorioidea. However, the uvea does not include the retina (see enclosed definition of the uvea). In Ishioka et al, it is disclosed that patients suffering from sympathetic ophthalmia, which is a form of uveitis, showed improvement following administration of FK506, but patients suffering from retinal vasculitis did not (see page 723, left column, lines 9-6 from the bottom).

At no point does Ishioka et al disclose or suggest that a compound within the scope of the present claims is effective for the treatment of retinopathy.

The Examiner cites Stuchlik et al for teaching lipophilic immunosuppressive agents that are obtained by dissolving or dispersing an immunosuppressant in a physiologically acceptable base containing an excipient to enhance permeation of drugs into ophthalmic tissue. Therefore, the disclosure of Stuchlik et al relates to enhancing the permeability of an

immunosuppressant through the cornea. However, Stuchlik et al do not compensate for the deficiencies in the disclosure of Ishioka et al. Specifically, Stuchlik et al fail to disclose or suggest a tricyclo compound of formula (I) or a pharmaceutically acceptable salt thereof for treating retinopathy.

MPEP §2142 states: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation... to modify the reference... Second, there must be a reasonable expectation of success. Finally, the prior art reference... must teach or suggest all the claim limitations." Even if the artisan were to combine the disclosures of Ishioka et al and Stuchlik et al the only expected advantage could be for treatment of uveitis. Therefore, the combined disclosures of Ishioka et al and Stuchlik et al would fail to render the present invention obvious as the combined disclosure fail to provide the requisite "reasonable expectation of success" for treatment of retinopathy.

Applicants request withdrawal of this ground of rejection.

The rejections of Claims 3, 4, and 6-8 under 35 U.S.C. §102(b) over Ryffel et al and Ishioka et al are obviated by amendment.

Claims 3, 4, and 6-8 have been canceled in response to the outstanding Office Action. Therefore, these grounds of rejection are believed to be moot. Withdrawal of these rejections is requested.

The rejection of Claims 15 and 16 under 35 U.S.C. §112, second paragraph, is obviated by amendment.

Claims 15 and 16 have been amended in accordance with the Examiner's kind suggestions. Specifically, Claims 15 and 16 have been amended to delete the term "is" in the

phrase "is comprises". Claims 15 and 16 have also been amended as suggested by the Examiner to replace the recitation of "%w/v" with "% weight per volume".

Applicants request withdrawal of this ground of rejection.

Applicants note that Ishioka et al (Am J Ophthalmol. 1994 Dec 15;118(6):723-9) has been first cited by the Examiner in the outstanding Office Action. However, based on a review of the prosecution history of the present application, this reference does not appear on a Form PTO-1449 (cited by applicant) or on a Form PTO-892 (cited by the Office). To ensure that this reference appears on the face of a patent that may issue from the present application, Applicants submit herewith a Form PTO-1449 listing this reference. Since the Office cited this reference, Applicants submit that no fee should be required for submission of the same. Moreover, Applicants submit that consideration of this reference should be acknowledged despite the final status of the outstanding Office Action.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

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